

REMARKS

Applicants acknowledge receipt of an Office Action dated September 24, 2007. In this response, Applicants have amended claims 1 and 5. Following entry of these amendments, claims 1 and 5-9 are pending in the application. Claims 7 and 8 have been withdrawn from consideration. Thus, claims 1, 5, 6, and 9 are currently pending and under consideration.

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Rejection Under 35 U.S.C. § 103

On page 2 of the Office Action, the PTO has rejected claims 1, 5, and 9 under 35 U.S.C. § 103(a) as allegedly being unpatentable over EP 0148718A2 to Panush (hereafter “Panush”) in view of U.S. Patent 6,291,018 to Dattilo (hereafter “Dattilo”). In addition, and also on page 2 of the Office Action, the PTO has rejected claim 6 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Panush in view of Dattilo, further in view of U.S. Patent 5,962,574 to Jackson *et al.* (hereafter “Jackson”). Applicants traverse these rejections for at least the reasons set forth in their previously filed response and for the additional reasons set forth below.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants’ disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Here, Panush, Dattilo, and Jackson, whether taken individually or in combination, fail to teach or suggest a method “wherein the primer paint comprises the second color pigment which is present in an amount ranging from an amount equal to or more than 0.03 wt% to an amount less than 1 wt% relative to a solid content of the primer paint” as recited in independent claim 1.

Furthermore, Applicants note that Panush, Dattilo, and Jackson, whether taken individually or in combination, fail to teach or suggest a method “wherein a hiding power of the color base paint coating is 30 μm or more” as recited in claim 1.

For at least these reasons, Applicants submit that the outstanding rejection based upon the combination of Panush, Dattilo and Jackson is improper and ought to be withdrawn.

On page 4 of the Office Action, the PTO states that “one of ordinary skill in the art would easily understand from Panush that. . . (ii) the primer that provides the primary hiding should have at least 1-20wt% of a pigment and 0.5 mils thickness that contains in less-than-hiding base coat.” (Original emphasis; new emphasis added). However, present claim 1 recites “an amount less than 1 wt%.” (emphasis added). As discussed in the present specification at page 5, lines 5-7, “if the content of the color pigment [contained in the primer paint] exceeds 1 wt%, ill effects are incurred to the adhesiveness and the weather resistance of the primer coating film.” (Emphasis and bracketed text added).

With regard to the hiding power of the color base paint, Applicants note that claim 1 currently recites a hiding power of “30 μm or more.” As discussed in the specification, “[h]iding power means the smallest film thickness whereby the color of a surface cannot be visually recognized and, specifically, the smallest film thickness wherein it becomes impossible to distinguish the color of black and white by the naked eye checking the color through the coating film coated on a black and white board.” (Emphasis added).

In the paragraph bridging pages 3 and 4 of the Office Action, the PTO has stated that “Panush also discloses that the amount of pigment blended with the base coat within 1-20 wt% (see page 3, lines 11-12) is sufficient to produce substrate hiding at 0.5 mils film (claimed more than 30 microns) thickness (See page 21, lines 19-22).” (Original emphasis deleted; parentheses original). Applicants note, however, that 0.5 mils is equal to 12.7 μm , which is less than 30 μm .

If an independent claim is nonobvious under § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). See MPEP 2143.03. Thus, Applicants submit that claims 5, 6, and 9, each of which ultimately depends from independent claim 1, are also non-obvious at least by virtue of their dependency from independent claim 1.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under § 103.

CONCLUSION

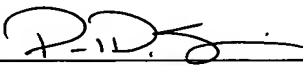
Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 12/26/07
FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5540
Facsimile: (202) 672-5399

By 
Paul D. Strain
Registration No. 47,369
Attorney for Applicants